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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/564,540

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Bei Wang

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS

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BRIARCLIFF MANOR, NY 10510

EXAMINER

PENDLETON, DIONNE

ART UNIT

PAPER NUMBER

2627

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/564,540	Applicant(s) WANG ET AL.	
	Examiner DIONNE H. PENDLETON	Art Unit 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. **Claim 5** is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Lines 1-5 of page 6 in the Applicant's specification, discloses that assigned area "30" is an area that "can not be recognized by optical-disc playing means."

However, in lines 7-9, the Applicant discloses that "the control information stored in assigned area 30 will be converted to the control information compliant to a standard and the converted one is stored in area 40."

The disclosure of lines 7-9 appears to contradict the disclosure of lines 1-5, as it is not immediately apparent to the Examiner how data which is stored in an area incapable of be recognized by a disc player, may have its data some how retrieved and converted by said disc player. Hence one of ordinary skill in the art would require undue experimentation to make or use the Applicant's invention.

Clarification is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claim 7** recites the limitation "the hard disc" in line 2. There is insufficient antecedent basis for this limitation in the claim.
3. **Claim 8** recites the limitation "the set-top terminal" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. **Claims 1-6 and 9-15** are rejected under 35 U.S.C. 102(e) as being anticipated by **Nakahara (US Patent No. 7,196,982)**.

Regarding claim 1,

Nakahara teaches a method for writing an optical disc, comprising: (a) writing a program onto the optical disc (column 9:43-60); (b) obtaining control information of the program (column 10:27-31, and 54-61); and (c) converting the control information of the program into control information compliant to a standard and storing the control information compliant to a standard on the optical disc (column 11:1-44).

Regarding claim 2,

Nakahara teaches the method according to claim 1, before step (c), repeating step (a) and (b) in order to write other programs ("S4" in figure 2 discloses that after recording initial program, if more programs are to be recorded, more programs are then received and recorded at "S3", until complete).

Regarding claim 3,

Nakahara teaches the method according to claim 1, further comprising: storing the control information of the program in an assigned area (see "IFO" in figure 3).

Regarding claim 4,

Nakahara teaches the method according to claim 3, wherein the assigned area is on the optical disc (see "IFO" in figure 3).

Regarding claim 5,

As best understood with regard to the U.S.C. 112 first paragraph rejection above, Nakahara teaches the method according to claim 4, wherein the assigned area on the optical disc is in the area unable to be identified by optical disc player.

Regarding claim 6,

Nakahara teaches the method according to claim 3, wherein the assigned area is in the storage area of the writing device (Examiner interprets the "navigation information

generator” as the “storage area” of the device, since control data is generated in said area, see column 10:58-67).

Regarding claim 9,

Nakahara teaches the method according to claim 1, wherein the control information comprises starting address of the program (column 7:49-57).

Regarding claim 10,

Nakahara teaches the method according to claim 9, wherein the control information comprises data encoding type of the program (column 2:27-35, and column 7:35-41).

Regarding claim 11,

Nakahara teaches the method according to claim 1, wherein the control information further comprises I frame of image (column 2:37-41 teaches that control data may pertain to MP3 formatted data).

Regarding claim 12,

Nakahara teaches the method according to claim 1, wherein the control information comprises an address of I frame of image (column 7:49-57).

Regarding claim 13,

Nakahara teaches the method according to claim 1, wherein the control information comprises starting address of the program and I frame of image (column 7:49-57).

Regarding claim 14,

Nakahara teaches an apparatus for writing an optical disc, comprising, means for writing a program onto the optical disc ("pickup" in figure 1); means for obtaining control information of the program ("8a" in figure 1, also column 10:27-31, 54-61); and means for converting the control information of the program into control information compliant to a standard and storing the control information compliant to a standard on the optical disc ("10" in figure 1).

Regarding claim 15,

Nakahara teaches the apparatus according to claim 14, further comprising encoding means for converting analog signals into digital signals ("A/D converter" in figure 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 7 and 8** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Nakahara (US Patent No. 7,196,982)**.

Regarding claims 7 and 8,

Nakahara teaches the method according to claim 6.

Nakahara does not explicitly teach that the assigned area is in the storage area of *the* hard disc or in the storage area of *the* set-top terminal of the writing device.

However, storage of a program to the hard disk of a device, or to a set-top terminal or similar home device, is well known in the art. One of ordinary skill in the art at the time of the invention would further store a program in said areas as a means of providing a back-up copy of said program for the user in the instance that the optical disc, on which a first copy is provided, is lost or destroyed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DIONNE H. PENDLETON whose telephone number is (571)272-7497. The examiner can normally be reached on 10:30-7:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young can be reached on 571-272-7582. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dionne H Pendleton/
Examiner, Art Unit 2627

/Wayne R. Young/
Supervisory Patent Examiner, Art Unit 2627